

DOCKET NO.: TIBO-0029/ VIP0009
Application No.: 09/836,477
Office Action Dated: October 06, 2006

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

REMARKS

Applicants acknowledge with appreciation the time and courtesies extended by the examiner toward applicants' representative during a telephone interview on November 2, 2006. The examiner's insights and comments have advanced the prosecution of the case. In particular, the outstanding rejections were discussed. Further discussion involved potential claim amendments in view of the non-statutory subject matter rejections. Applicants address the examiner's remarks in the order presented in the October 6, 2006 Office Action. All claim amendments are made without prejudice and do not represent acquiescence in any ground of rejection.

STATUS OF THE CLAIMS

Claims 1-4, 8, 13, 16-25, 28-32 and 39-41 are currently pending. Claims 1, 28, and 39 were amended. Support for the amendment to the claims can be found throughout the application as filed. For example, support for "f) displaying the phenotype of the Human Immunodeficiency Virus sample" amendment in claim 39 can be found on page 14, first full paragraph, and at page 19, second full paragraph. Further support can be found in Figure 3 as filed. No new matter has been added by this amendment. With this Reply, claims 1-3, 8, 13, 16-25, 28-32 and 39-41 will be pending.

Claims 39-41 stand rejected under 35 U.S.C. §101 because the examiner stated the claimed invention is directed to non-statutory subject matter.

Claims 1-3, 8, 13, 16-25, 28-32 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

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REJECTIONS UNDER 35 U.S.C. § 101

Claims 39-41 remain rejected under 35 U.S.C. §101 because the examiner stated the claimed invention is allegedly directed to non-statutory subject matter for the reasons set forth in the previous Office Action.

Applicants stated in their previous reply that claim 39 is directed to a computer program wherein the program is on a computer readable medium and that according to the Guidelines (November 2005) “a computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer's functionality to be realized, and is thus statutory.” The examiner did not find this persuasive.

As discussed during the November 2, 2006 telephone interview, applicants amended the claims for clarity and consistency of claim language. Without acceding to the propriety of the rejection of pending claims 23-24, 26-27, 34-37, and 39-45 under 35 U.S.C. §101, applicants respectfully request reconsideration of the claims as amended. For these reasons, applicants request the examiner to withdraw the rejection of pending claims 23-44 under 35 U.S.C. §101.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH (INDEFINITENESS)

Claims 1-3, 8, 13, 16-25, and 28-32 are rejected under 35 U.S.C. 112, second paragraph, as being allegedly indefinite.

According to the examiner, claims 1 and 28 as amended recite “obtaining from a patient a sample...”. The examiner was of the opinion that it is unclear what relationship of this step with the remainder of the claimed method steps is intended, as the sample is never used in an active method step. The examiner further states that step (b) provides for obtaining

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a generic sequence, however, it was unclear to the examiner if this sequence is taken from DNA from the patient sample of step (a) or from some other source.

Without acceding to the propriety of the rejection of pending claims 1-3, 8, 13, 16-25, and 28-32 under U.S.C. §112, second paragraph, applicants respectfully request reconsideration of the claims as amended. For these reasons, applicants request the examiner to withdraw the rejection of pending claims 1-3, 8, 13, 16-25, and 28-32 under 35 U.S.C. §112, first paragraph.

The foregoing represents a *bona fide* attempt to advance the present case to allowance. Applicants submit that this application is now in condition for allowance.

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